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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,635	08/19/2003	Gregory A. Piccionelli	39003.809US01	7528
7590	05/24/2006			EXAMINER GART, MATTHEW S
Anna M. Vradenburgh, Esq. Brull Piccionelli Sarno Braun & Vradenburgh 1925 Century Park East, Suite 2350 Los Angeles, CA 90067			ART UNIT 3625	PAPER NUMBER

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/644,635	PICCIONELLI ET AL.	
	Examiner Matthew S. Gart	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 8/19/2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Drawings

The drawings filed on 8/19/2003 contain improper handwritten text. Formal drawings in compliance with 37 CFR 1.121(d) are required in this application. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

Claim 8 is objected to because of the following informalities:

Claim 8, step iii) recites, "Providing all names used by the performer other than the performer's legal name when the performer has at least name other than the performer's legal name." Claim 8, step iii) should be amended to read, "Providing all names used by the performer other than the performer's legal name when the performer has at least a name other than the performer's legal name."

Appropriate correction is required.

Claim 22 is objected to because of the following informalities:

Claim 22, step i) b) recites, "All names used by the performer of a recorded performance other than the performer's legal name when the performer has at least name other than the performer's legal name." Claim 22, step i) b) should be amended to read, "All names used by the performer of a recorded performance other than the performer's legal name when the performer has at least a name other than the performer's legal name."

Claim 22 has two separate steps labeled i) b). The latter of the i) b) steps should be relabeled i) d).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by BayTSP (PTO-892, Ref U).

Referring to claim 24. BayTSP discloses a method of producing a record of a performance, the performance being transmitted over a network, the performance being subject to a record-keeping requirement, the method comprising the steps of:

- i) providing information pertaining to a performance in accordance with a record-keeping requirement (BayTSP: page 8, "BayTSP.com's 2257 suite of products requires customers to submit personally identifiable information about adult entertainment performers in order to comply with federal recording keeping compliance regulations set forth by 18 U.S.C. 2257."),
- ii) associating the information with the performance (BayTSP: page 8, "BayTSP.com's 2257 products embed 2 forms of identification for each performer in each image."),
- iii) providing the associated information to a custodian (BayTSP: page 12, "2257Custodian is a service for web masters who are required to comply with U.S. Code 2257 by maintaining compliance documentation for every performer depicted on a site containing sexually explicit material."), and

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- iv) providing means enabling a viewer to access information pertaining to the performance and to the custodian over the network (BayTSP: page 9, "2257Brans").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 4-5, 8-9, 11-15, 17-19, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over BayTSP (PTO-892, Ref U) in view of Barone (U.S. Patent Application Number 2003/0051238).

Referring to claim 1. BayTSP discloses a method of producing media, the media being transmitted over a network, the media being subject to a record-keeping requirement, the method comprising the steps of:

- i) providing information pertaining to media in accordance with a record-keeping requirement (BayTSP: page 8, "BayTSP.com's 2257 suite of products requires customers to submit personally identifiable information about adult entertainment performers in order to comply with federal recording keeping compliance regulations set forth by 18 U.S.C. 2257."),
- ii) associating the information with the media performance (BayTSP: page 8, "BayTSP.com's 2257 products embed 2 forms of identification for each performer in each image."),
- iii) providing the associated information to a custodian (BayTSP: page 12, "2257Custodian is a service for web masters who are required to comply with

U.S. Code 2257 by maintaining compliance documentation for every performer depicted on a site containing sexually explicit material."), and

- iv) transmitting the media over a network (BayTSP: page 12, "online content."),

BayTSP does not expressly disclose a method of producing a live performance, the live performance being transmitted over a network, the live performance being subject to a record-keeping requirement.

Barone discloses a method of producing a live performance, the live performance being transmitted over a network, the live performance being subject to a record-keeping requirement. Barone is directed to a system for embedding in a video program, content ratings, content advisories, demographic information, and other types of record keeping requirements. The video source **10** provides live or recorded video programs to the encoder for embedding data into the video program (Barone: paragraph 0018). Once encoded the video source **10** is transmitted over a serial or network link **36**, such as for example, a local area network (LAN) or wide area network (WAN) link.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of BayTSP to have included the teachings of Barone as discussed above in order to allow a viewer to experience an enhanced television program (Barone: paragraph 0004).

Referring to claim 2. BayTSP further discloses a method wherein the media is transmitted over a computer network to a viewer (BayTSP: page 12, "The United States

Federal Government has established practices relating to the use and/or maintenance of particular types of online content.").

Referring to claim 4. BayTSP further discloses a method wherein step (iv) is performed only after the completion of step (iii) (BayTSP: page 12, "BayTSP.com will maintain a database of their site's content that has been pre-screened by a BayTSP.com partner to confirm that is legally compliant.").

Referring to claim 5. BayTSP further discloses a method wherein prior to step (iv) the viewer provides to a site that controls transmission of the media verification that the viewing of the media is legally permissible at the viewer's physical location (BayTSP: page 11, "2257Filter").

Referring to claim 8. BayTSP discloses a method of producing media, the media being transmitted over a network, the method comprising the steps of:

- i) providing an identification of a performer (BayTSP: page 19, "2257(b)'),
- ii) verifying the identification of the performer (BayTSP: page 19, "2257(b)'),
- iii) providing all names used by the performer other than the performer's legal name when the performer has at least a name other than the performer's legal name (BayTSP: page 19, "2257(b)'),
- iv) providing
 - a) an identification of the performance (BayTSP: page 12), and

- b) a date of the performance (BayTSP: page 12),
- v) associating the information providing in steps i), iii) and iv) (BayTSP: page 8, "BayTSP.com's 2257 products embed 2 forms of identification for each performer in each image."),
- vi) providing the information associated in step v) to a custodian (BayTSP: page 12, "2257Custodian is a service for web masters who are required to comply with U.S. Code 2257 by maintaining compliance documentation for every performer depicted on a site containing sexually explicit material."), and
- vii) transmitting the performance over a network (BayTSP: page 12, "online content.").

BayTSP does not expressly disclose a method of producing a live performance, the live performance being transmitted over a network, the live performance being subject to a record-keeping requirement.

Barone discloses a method of producing a live performance, the live performance being transmitted over a network, the live performance being subject to a record-keeping requirement. Barone is directed to a system for embedding in a video program, content ratings, content advisories, demographic information, and other types of record keeping requirements. The video source **10** provides live or recorded video programs to the encoder for embedding data into the video program (Barone: paragraph 0018). Once encoded the video source **10** is transmitted over a serial or network link **36**, such as for example, a local area network (LAN) or wide area network (WAN) link.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of BayTSP to have included the teachings of Barone as discussed above in order to allow a viewer to experience an enhanced television program (Barone: paragraph 0004).

Referring to claim 9. BayTSP further discloses a method wherein the media is transmitted over a computer network to a viewer (BayTSP: page 12, "The United States Federal Government has established practices relating to the use and/or maintenance of particular types of online content.").

Referring to claim 11. BayTSP further discloses a method wherein the identification of the performance is a title or an identification number. (BayTSP: page 8, "birth date").

Referring to claim 12. BayTSP further discloses a method wherein the live performance is performed by a plurality of performers, and wherein steps (i) – (vi) are carried out with respect to each of said plurality of performers (BayTSP: page 19, "Any person to whom subsection (a) applies shall, with respect to every performer portrayed in a visual depiction of actual sexually explicit conduct..."),

Referring to claim 13. BayTSP further discloses a method wherein step (vii) is performed only after the completion of step (vi) (BayTSP: page 12, "BayTSP.com will

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maintain a database of their site's content that has been pre-screened by a BayTSP.com partner to confirm that is legally compliant.").

Referring to claims 14-15 and 17-19. The limitations of claims 14-15 and 17-19 closely parallel those of claims 8-9 and 11-13. Claims 14-15 and 17-19 are rejected under the same rationale as set forth above in claims 8-9 and 11-13.

Referring to claim 23. The limitations of claim 23 closely parallel those of claim

1. Claim 23 is rejected under the same rationale as set forth above in claim 1.

Referring to claim 25. The limitations of claim 25 closely parallel those of claim

1. Claim 25 is rejected under the same rationale as set forth above in claim 1.

Claims 3, 6-7, 10, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over BayTSP (PTO-892, Ref U) in view of Barone (U.S. Patent Application Number 2003/0051238) in further view of VideoChat (PTO-892, Ref V).

Referring to claim 3. BayTSP in view of Barone discloses a method according to claim 2 as indicated supra. Neither BayTSP nor Barone disclose a method wherein the viewer is provided with a statement prior to the transmission of the media, the statement comprising information pertaining to the media in accordance with the record-keeping requirement and a location of the custodian.

VideoChat discloses a method wherein the viewer is provided with a statement prior to the transmission of the media, the statement comprising information pertaining to the media in accordance with the record-keeping requirement and a location of the custodian (VideoChat: page 1 "Record-Keeping Information").

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of BayTSP in view of Barone to have included the teachings of VideoChat as discussed above because some websites are "not intended to be viewed by minors." (VideoChat: page 1).

Referring to claim 6. BayTSP in view of Barone discloses a method according to claim 5 as indicated supra. Neither BayTSP nor Barone disclose a method wherein the viewer provides a credit card account number to the site that controls transmission of the live performance.

VideoChat discloses a method wherein the viewer provides a credit card account number to the site that controls transmission of the live performance (VideoChat: page 2, "Click Here to Cancel Your Account Online").

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of BayTSP in view of Barone to have included the credit card processing means of VideoChat in order to allow a content owner a means to deter the theft and misuse of valuable online content. Furthermore, it is well known in the art, that owners of content provide online access to their content in exchange for some reward, monetary or otherwise.

Referring to claim 7. BayTSP in view of Barone discloses a method according to claim 5 as indicated supra. Neither BayTSP nor Barone disclose a method wherein the viewer is charged a premium prior to step (iv).

VideoChat discloses a method wherein the viewer is charged a premium prior to step (iv) (VideoChat: page 2). Videochat discloses a method wherein a user signs up for a \$2.95 trial access membership. After the trial membership expires, the user can obtain a full price membership subscription.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of BayTSP in view of Barone to have included the credit card processing means of VideoChat in order to allow a content owner a means to deter the theft and misuse of valuable online content. Furthermore, it

is well known in the art, that owners of content provide online access to their content in exchange for some reward, monetary or otherwise.

Referring to claims 10 and 16. The limitations of claim 10 closely parallel those of claim 3. Claim 10 is rejected under the same rationale as set forth above in claim 3.

Referring to claim 20. The limitations of claim 20 closely parallel those of claims 8 and 10. Claim 20 is rejected under the same rationale as set forth above in claims 8 and 10.

Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over BayTSP (PTO-892, Ref U) in view of VideoChat (PTO-892, Ref V).

Referring to claim 21. BayTSP discloses a method of providing a recorded performance to a viewer over a network, the recorded performance being subject to a record-keeping requirement, the method comprising the steps of:

- i) providing to a custodian information pertaining to a recorded performance in accordance with a record-keeping requirement (BayTSP: page 12, "2257Custodian is a service for web masters who are required to comply with U.S. Code 2257 by maintaining compliance documentation for every performer depicted on a site containing sexually explicit material."), and
- iii) transmitting the recorded performance to a viewer over the network (BayTSP: page 12, "online content.").

BayTSP does not disclose a method comprising the step of providing a statement to a viewer over a network prior to the transmission of the recorded performance to the viewer, the statement comprising information pertaining to the recorded performance and to the custodian in accordance with the record-keeping requirement.

VideoChat discloses a method comprising the step of providing a statement to a viewer over a network prior to the transmission of a recorded performance to a viewer, the statement comprising information pertaining to the recorded performance and to the

custodian in accordance with the record-keeping requirement (VideoChat: page 1 “Record-Keeping Information”).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of BayTSP to have included the teachings of VideoChat as discussed above because some websites are “not intended to be viewed by minors.” (VideoChat: page 1).

Referring to claim 22. BayTSP discloses a method of providing a recorded performance to a viewer over a network, the method comprising the steps of:

- i) providing to a custodian
 - a) a verified identification of a performer of a recorded performance (BayTSP: page 19, “2257(b”)),
 - b) all names used by the performer of a recorded performance other than the performer’s legal name when the performer has at least a name other than the performer’s legal name (BayTSP: page 19, “2257(b”)),
 - c) an identification of the recorded performance (BayTSP: page 12), and
 - d) a date of the recorded performance (BayTSP: page 12), and
- iii) transmitting the performance over a network (BayTSP: page 12, “online content.”).

BayTSP does not disclose a method comprising the step of providing a statement to a viewer over a network prior to the transmission of the recorded

performance to the viewer, the statement comprising information pertaining to the recorded performance and to the custodian in accordance with the record-keeping requirement.

VideoChat discloses a method comprising the step of providing a statement to a viewer over a network prior to the transmission of a recorded performance to a viewer, the statement comprising information pertaining to the recorded performance and to the custodian in accordance with the record-keeping requirement (VideoChat: page 1 "Record-Keeping Information").

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of BayTSP to have included the teachings of VideoChat as discussed above because some websites are "not intended to be viewed by minors." (VideoChat: page 1).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Testimony of Mark M. Ishikawa, CEO, BayTSP.com, Inc., Before the Commission On Online Child Protection "Other Technologies and Methods", San Jose State University, San Jose, CA, August 4, 2000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-273-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MSG
Primary Examiner
May 20, 2006